

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

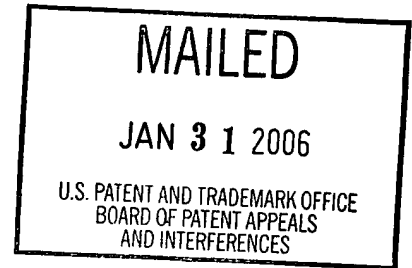
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte KENNETH S. POLONSKY, YUKIO HORIKAWA, NAOHISA ODA,
NANCY J. COX, KENICHI OTANI, CRAIG L. HANIS, GRAEME I. BELL,
SEAMUS KEVIN SREENAN, and YUN-PING ZHOU

Appeal No. 2005-0258
Application No. 09/768,877

ON BRIEF



Before ELLIS, ADAMS, and GREEN Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

REQUEST FOR REHEARING¹

Appellants request reconsideration (rehearing) of the Board's Decision entered July 29, 2005, wherein the examiner's rejection of claims 18-21, 49-51, 53-64, 115 and 116 under the written description provision of 35 U.S.C. § 112 was affirmed.

DISCUSSION

Appellants' premise their request upon their disagreement with the manner in which the Board grouped claims 18-21, 49-51, 53-64, 115 and 116 in

¹ All reference to Request, refers to appellants' Request for Rehearing received by the Board of Patent Appeals and Interferences on October 4, 2005. We note appellants' Certificate of Mailing under 37 CFR § 1.8, dated September 29, 2005. Accordingly, appellants' Request is timely filed.

the rejection under the written description provision of 35 U.S.C. § 112, first paragraph. As we understand appellants' assertions (Request, page 3), appellants' Brief presented two separate arguments against the rejection under the written description provision of 35 U.S.C. § 112, first paragraph. The first, (presented in the Brief at page 13) provided arguments for claims 19 and 53, while the second (presented in the Brief at pages 14-17) provided arguments for claims 18-21, 49-51, 53-64, 115 and 116.

Appellants cite (see Request, page 3), but do not contest the Board's reliance on 37 CFR § 1.192(c)(7)(2002) which states:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the group for rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under [paragraph] (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

For clarity we will address each requirement of 37 CFR § 1.192(c)(7)(2002) separately.

I. For each groups of rejection:

The following four grounds of rejection were identified at page 3 of the Decision:

- I. Claims 18-21, 49-51, 53-64, 115 and 116 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in the recitation of the term "calpain 10."

- II. Claims 19, 49 and 53 stand rejected under 35 U.S.C. § 112, first paragraph, as the specification fails to adequately describe the claimed invention.
- III. Claims 18-21, 49-51, 53-64, 115 and 116 stand rejected under 35 U.S.C. § 112, first paragraph, as the specification fails to adequately describe the claimed invention.
- IV. Claims 18-21, 49-51, 53-64, 115 and 116 stand rejected under 35 U.S.C. § 112, first paragraph, as based on an insufficient disclosure to support or enable the scope of the claimed invention.

We direct attention to the second and third ground of rejection. The second ground of rejection is a rejection of claims 19, 49² and 53 under the written description provision of 35 U.S.C. § 112, first paragraph. At page 6 of the Answer, the examiner refers to this rejection as “a new matter rejection.” See also, Decision page 4, wherein the rejection is discussed under the heading “New Matter.” According to the examiner (Answer, page 7), “there is no indication that methods using specifically calpain 10 polypeptides which comprise amino acids 1-47 of SEQ ID NO: 2 were within the scope of the invention as conceived by [a]ppellants at the time the application was filed.” See also, Decision, page 4. Throughout the statement of this rejection the examiner focuses on “amino acids 1-47 of SEQ ID NO: 2.” Appellants’ statement of the issues, as it appears on pages 4 and 5 of the Brief, recognizes the examiner’s focus on the phrase “amino acids 1-47 of SEQ ID NO: 2.” In this regard, we note

² According to the examiner (Answer, page 6), claims 19 and 53 “encompass a method of screening for a modulator of calpain 10 function wherein the calpain 10 polypeptide used comprises amino acids 1-47 of SEQ ID NO:2.” As we understand it, claim 49 is included in this rejection due to its dependency on claim 19. See id.

that appellants' specifically characterize this issue as whether "claims 19 and 53 lack written description under 35 U.S.C. [§] 112, first paragraph for the phrase 'amino acids 1-47 of SEQ ID NO: 2?'" Brief, pages 4 and 5. Appellants do not dispute our decision on the merits of this ground of rejection.

Appellants' Request is directed to our decision on the merits of the third ground of rejection. The third ground of rejection is a rejection of claims 18-21, 49-51, 53-64, 115 and 116 under the written description provision of 35 U.S.C. § 112, first paragraph, as the specification fails to adequately describe the claimed invention. This ground of rejection differs from the second ground of rejection because it is not based on the concept of "new matter" but instead focuses on the failure of appellants' specification to provide written descriptive support for the genus of calpain 10 polypeptides set forth in claim 51. See e.g., Decision page 8, "the method of claim 51 is open to the use of a calpain 10 polypeptide of any structure from any source. Therefore, the method of claim 51 reads generically on the use of any calpain 10 polypeptide from any source." Appellants' Request does not dispute this construction of claim 51. In addition, we note that appellants' statement of the issues, as it appears on pages 4 and 5 of the Brief, specifically characterize this issue as whether "claims 18-21, 49-51, and 53-64 lack written description under 35 U.S.C. [§] 112, first paragraph for the phrase 'calpain 10?'"

II. Appellants' statement of the claim groupings:

Regarding the second ground of rejection, the new matter rejection, appellants assert (Brief, bridging paragraph, pages 6-7), "[c]laims 19 and 53 do not stand or fall with the other claims relative to the written description rejection under 35 U.S.C. [§] 112, first paragraph, based on the phrase 'amino acids 1-47 of SEQ ID NO: 2' because only claims 19 and 53 recite the phrase 'amino acids 1-47 of SEQ ID NO: 2.'" Accordingly, as we understand it, this statement relates to the new matter rejection of claims 19, 49 and 53, and does not relate to the third ground of rejection. In support of this conclusion, we note appellants' recognition of this rejection as a separate issue on appeal (Brief, pages 4 and 5), and appellants' separate reference to claims 19 and 53 in their discussion of the claim grouping for the third ground of rejection (Brief, page 7).

Appellants make two assertions (Brief, page 7, emphasis added), with regard to the third ground of rejection:

1. Claims 18-21, 49-51 and 53-64 do not stand or fall with the other claims relative to the written description rejection under 35 U.S.C. [§] 112, first paragraph, based on the phrase "calpain 10" because only claims 18-21, 49-51 and 53-64 recite the phrase "calpain 10."
2. Additionally, claims 19 and 53, stand or fall separately from claims 18, 20, 21, 49, 51, 54-55, and 57-60 in regard to this rejection because, even though all of the claims are have [sic] written description in the specification, claims 19 and 53 have additional amino acid sequence recitations upon which additional arguments for the patentability of the claims may be based.

The Decision recognized appellants' statement that claims 19 and 53 were grouped separately from claims 18, 20, 21, 49, 51, 54-55, and 57-60. See

Decision, page 7. 37 CFR § 1.192(c)(7)(2002), however, does not end with a requirement that appellants provide an assertion that the claims do not stand or fall together. To the contrary, the Rule requires that appellants state “that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable.” Id., emphasis added.

III. Appellants’ argument for each claim grouping of each ground of rejection:

Appellants’ arguments relating to the third ground of rejection appear at pages 14-17 of the Brief. At no time do appellants address the separate patentability of claims 19 and 53 on pages 14-17. In this regard, we note that appellants admit that “claims 18-21, 49-51 and 53-64 are argued generally” on pages 14-17 of their Brief. See Request, page 3.

CONCLUSION

From the foregoing it is clear that appellants have not only separately argued the second (page 13) and third rejections (pages 14-17) under separate headers, they have provided separate claim groupings for the second and third ground of rejection (see pages 6-7). While, we recognize appellants’ reference to page 13 of the Brief (Request, page 3), we note that this section of the Brief refers to a discussion of the second ground of rejection, as it relates to the phrase “amino acids 1-47 of SEQ ID NO: 2,” and does not relate to the third ground of rejection. Further, while appellants state (Brief, page 7, emphasis

added), "claims 19 and 53 have additional amino acid sequence recitations upon which additional arguments for the patentability of the claims may be made," appellants failed to make additional arguments in the argument section of this ground of rejection. In addition, to the extent that appellants would assert that they satisfied their requirement to separately argue the patentability of claims 19 and 53 by pointing out on page 7 of their Brief that "claims 19 and 53 have additional amino acid sequence recitations," we note that according to 37 CFR § 1.192(c)(7)(2002) "[m]erely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." Accordingly, upon review of the record we find no argument for the separate patentability of claims 19 and 53 as they relate to the third ground of rejection on this record.

On reflection, we have carefully reviewed the original opinion in light of appellants' request, but we find no point of law or fact that we overlooked or misapprehended in arriving at our decision. To the extent relevant, appellants' request amounts to a reargument of points already considered by the board. Therefore, appellants' request has been granted to the extent that the decision has been reconsidered, but such request is denied with respect to making any modifications to the decision affirming the examiner's rejection of claims 18-21, 49-51, 53-64, 115 and 116 under the written description provision of 35 U.S.C. § 112, first paragraph.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REHEARING DENIED

Ellis

Joan Ellis
Administrative Patent Judge

W. E. Lyons

Donald E. Adams
Administrative Patent Judge

Team 2

Lora M. Green
Administrative Patent Judge

BOARD OF PATENT

APPEALS AND

INTERFERENCES

Gina N. Shishima
FULBRIGHT & JAWORSKI L.L.P.
Suite 2400
600 Congress Avenue
Austin TX 78701